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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/742,699	12/20/2000	Ajit S. Shah	PA1273US	9128
22830	7590	07/05/2006	EXAMINER	
CARR & FERRELL LLP 2200 GENG ROAD PALO ALTO, CA 94303			WOO, ISAAC M	
			ART UNIT	PAPER NUMBER
			2166	

DATE MAILED: 07/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/742,699

Applicant(s)

SHAH ET AL.

Examiner

Isaac M. Woo

Art Unit

2166

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 13 April 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 27-49 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 27-49 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

### **DETAILED ACTION**

1. This action is in response to Applicant's Amendments filed on April 03, 2006 have been considered but are deemed moot in view of new ground of rejections below.
2. Claims 1-26 are canceled. Claims 27-49 are newly added. And claims 27-49 are now pending.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 27-49 are rejected under 35 U.S.C. 102(e) as being anticipated by Liu et al (U.S. Patent No. 6,216,131, hereinafter, "Liu").

With respect to claim 27, Liu teaches an engine configured to determine an identity of a first party (i.e., REX hand held device, 154, fig. 1, col. 4, lines 13-18) to be provided personal information (i.e., contact file for synchronizing, fig. 3B, col. 5, lines 47-

67 to col. 6, lines 1-18), determine whether a selected field of the personal information of a second party can be provided to the first party (i.e., from selected card file with each field of personal information is mapped (selected) in fig. 3D, col. 6, lines 47-67 to col. 7, lines 1-9), and provide the selected field of the personal information of the second party (i.e. desktop PC, 100 in fig. 1, col. 5, lines 34-47, col. 4, lines 1-19) to the first party (i.e., REX hand held device, 154, fig. 1, col. 4, lines 13-18) (i.e., synchronization personal information from PC to REX hand held device, fig. 3G, col. 7, lines 8-31); and database configured to store at least one field of the personal information (i.e., personal information is synchronized and stored, col. 2, lines 43-55, col. 3, lines 20-38, col. 6, lines 47-65).

With respect to clam 28, Liu teaches determine whether the selected field of the personal information of the second party can be provided to the first party using a unique identifier of the second party (col. 7, lines 31-67 to col. 8, lines 1-58).

With respect to clam 29, Liu teaches determine whether the selected field of the personal information of the second party can be provided to the first party using a unique identifier of the first party (col. 7, lines 31-67 to col. 8, lines 1-58).

With respect to clam 30, Liu teaches receive a message indicating a request from the first party for the selected field of the personal information of the second party

and to process the message to provide the selected field of the personal information to the first party (i.e., synchronizing button, 351, fig. 3G, col. 7, lines 19-30).

With respect to clam 31, Liu teaches receive a message indicating a request from the second party for the selected field of the personal information of the second party and to process the message to provide the selected field of the personal information to the first party (i.e., synchronizing, col. 7, lines 19-30).

With respect to clam 32, Liu teaches process one or more customized fields of the personal information received from the second party (i.e., synchronizing, col. 7, lines 19-30).

With respect to clam 33, Liu teaches receive a permission from the second party, to determine whether the selected filed can be provided to the first party based on permission (i.e., by synchronizing button, 351, fig. 3G, col. 7, lines 19-30, col. 6, lines 18-47).

With respect to clam 34, Liu teaches receive a defined period of time that indicates how long to share the selected field (col. 6, lines 18-47).

With respect to clam 35, Liu teaches determining the identity of a first party (i.e., REX hand held device, 154, fig. 1, col. 4, lines 13-18) to be provided personal

information (i.e., contact file for synchronizing, fig. 3B, col. 5, lines 47-67 to col. 6, lines 1-18); storing in a database at least one field of the personal information of a second party (i.e., personal information is synchronized and stored, col. 2, lines 43-55, col. 3, lines 20-38, col. 6, lines 47-65); determining whether a selected field of the personal information of the second party can be provided to the first party (i.e., from selected card file with each field of personal information is mapped (selected) in fig. 3D, col. 6, lines 47-67 to col. 7, lines 1-9); and providing the selected field of the personal information of the second party to the first party (i.e., synchronization personal information from PC to REX hand held device, fig. 3G, col. 7, lines 8-31).

With respect to claim 36, Liu teaches determining whether the selected field of the personal information of the second party can be provided to the first party uses a unique identifier of the second party (col. 7, lines 31-67 to col. 8, lines 1-58).

With respect to claim 37, Liu teaches determining whether the selected field of the personal information of the second party can be provided to the first party uses a unique identifier of the first party. (col. 7, lines 31-67 to col. 8, lines 1-58).

With respect to claim 38, Liu teaches receiving a message indicating a request from the first party for the selected field of the personal information of the second party and processing the message to provide the selected field of the personal information to the first party (i.e., synchronizing button, 351, fig. 3G, col. 7, lines 19-30).

With respect to claim 39, Liu teaches receiving a message indicating a request from the second party for the selected field of the personal information of the second party and providing the selected field of the personal information to the first party (i.e., synchronizing button, 351, fig. 3G, col. 7, lines 19-30).

With respect to claim 40, Liu teaches transmitting a message to one or more third parties when the selected field is updated, where the selected field can be provided to the one or more third parties (i.e., laptop, 152, fig. 1, col. 7, lines 8-31).

With respect to claim 41, Liu teaches receiving a defined period time that indicates how long to share the selected field (col. 6, lines 18-47).

With respect to claim 42, Liu teaches receiving a permission from the second party, to determine whether the selected field can be provided to the first party based on the permission (i.e., by synchronizing button, 351, fig. 3G, col. 7, lines 19-30, col. 6, lines 18-47).

With respect to claim 43, Liu teaches software operational when executed by the processor to direct the processor to determine an identity of a first party (i.e., REX hand held device, 154, fig. 1, col. 4, lines 13-18) to be provided personal information (i.e., contact file for synchronizing, fig. 3B, col. 5, lines 47-67 to col. 6, lines 1-18); determine

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whether a selected field of the personal information of a second party can be provided to the first party (i.e., from selected card file with each field of personal information is mapped (selected) in fig. 3D, col. 6, lines 47-67 to col. 7, lines 1-9), and provide the selected field of the personal information of the second party to the first party (i.e., synchronization personal information from PC to REX hand held device, fig. 3G, col. 7, lines 8-31); and a computer readable medium configured to store the software (i.e., personal information is synchronized and stored, col. 2, lines 43-55, col. 3, lines 20-38, col. 6, lines 47-65).

With respect to claim 44, Liu teaches determine whether the selected field of the personal information of the second party can be provided to the first party using a unique identifier of the second party (col. 7, lines 31-67 to col. 8, lines 1-58).

With respect to claim 45, Liu teaches determine whether the selected field of the personal information of the second party can be provided to the first party using a unique identifier of the first party (col. 7, lines 31-67 to col. 8, lines 1-58).

With respect to claim 46, Liu teaches receive a message indicating a request from the first party for the selected field of the personal information of the second party and to process the message to provide the selected field of the personal information to the first party (i.e., synchronizing button, 351, fig. 3G, col. 7, lines 19-30).



With respect to claim 47, Liu teaches receive a message indicating a request from the second party for the selected field of the personal information of the second party and to process the message to provide the selected field of the personal information to the first party. (i.e., synchronizing, fig. 3G, col. 7, lines 19-30).

With respect to claim 48, Liu teaches process one or more customized fields of the personal information received from the second party(i.e., synchronizing, col. 7, lines 19-30).

With respect to claim 49, Liu teaches transmit a message to one or more third parties when the selected field is updated, where the selected field can be provided to the one or more third parties (i.e., laptop, 152, fig. 1, col. 7, lines 8-31).

***Conclusion***

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.


**Contact Information**

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Isaac M. Woo whose telephone number is (571) 272-4043. The examiner can normally be reached on 8:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hosain T. Alam can be reached on (571) 272-3978. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

IW  
June 20, 2006

  
JEAN M. CORRIELUS  
PRIMARY EXAMINER